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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,707	06/05/2001	Dan Kikinis	ISURFTV137	7928
52940	7590	11/16/2005	EXAMINER	
TODD S. PARKHURST HOLLAND & KNIGHT LLP 131 S. DEARBORN STREET 30TH FLOOR CHICAGO, IL 60603			LAYE, JADE O	
		ART UNIT		PAPER NUMBER
		2617		
DATE MAILED: 11/16/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/875,707	KIKINIS ET AL.
	Examiner	Art Unit
	Jade O. Laye	2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 October 2005.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 24 October 2005 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
- Certified copies of the priority documents have been received.
  - Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

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### ***Response to Arguments***

1. Applicant's amendments, dated 10/24/05, have been entered and made of record.
  
2. Applicant's arguments, dated 10/24/05, with respect to all claims have been considered but are moot in view of the new ground(s) of rejection, which was necessitated by Applicant amended claim language. Accordingly, **THIS ACTION IS MADE FINAL**.

*[Note: Applicant's argument regarding the Elliot reference will be addressed within the rejection below.]*

3. Due to Applicant's amended Specification, Drawings, and Claims, the objections applied in the previous Non-Final Action are hereby withdrawn.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-5, 7-13, 15-21, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al (US Pat. Pub. No. 2005/0028208) in view of Sorensen (US Pat. No. 6,628,729).

Claim 1 recites an entertainment system comprising:

- a. A unit to transmit information and to receive information via a wireless connection;
- b. a plurality of hand held devices capable of simultaneously communicating with said unit, wherein each entertainment system comprises a control unit to interact with an electronic programming guide (EPG); and
- c. an indicator to indicate an availability of an interactive function in a program corresponding to the EPG.

As to Claim 1, Ellis et al disclose an entertainment system comprises a distribution center capable of simultaneously communicating with a plurality of EPG functional hand-held devices via a wireless connection. (Abstract; Par. [0002, 0010, 0066-0068, 0077, 0102]). But, Ellis fails to disclose the remaining limitations of Claim 1. However, within the same field of endeavor, Sorensen discloses a similar system in which permits remote access to data, such as an Internet address, embedded in a broadcast program received by a receiver. The system is also capable of indicating the availability of interactive data corresponding to broadcast programming being received by the system. (Col. 1, Ln. 7-10, 30-40, 50-67 thru Col. 2, Ln. 1-8 & Col. 3, Ln. 22-36). Therefore, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Ellis and Sorensen in order to provide a device capable of alerting a user to the presence of interactive broadcast data corresponding to an EPG, thereby providing a remote with extended functionality.

Claims 9 and 17 correspond to the entertainment system claim 1. Accordingly, each is analyzed and rejected as previously discussed.

Applicant argues that Sorensen fails to disclose a system or method of prompting a user to the presence of an interactive data is present which corresponds to a “program corresponding to the EPG,” and therefore does not disclose the claimed invention. (Appl. Response, Pg. 9). The Examiner disagrees. At Column 1, Lines 50-53, Sorensen specifically discloses that the invention allows access to supplemental data embedded in a “program.” Although the disclosure only speaks to coupons and URL’s relating to commercials as exemplary embodiments, the Examiner broadly interprets this data to correspond to “programming.” Moreover, it was notoriously well-known at the time of Applicant’s invention to transmit supplemental data which relates to broadcast programming. Accordingly, the combination of Ellis and Sorensen discloses all limitations of Claim 1.

Claim 2 recites the entertainment system of claim 1, wherein the indicator is displayed on a display of the entertainment system. As discussed above, the combined systems of Ellis and Sorensen disclose all limitations of claim 1, and Sorensen further teaches that the personal digital assistant (PDA) may generate *any form* of notification to alert the user to the presence of interactive data. (Col. 3, Ln. 22-36). Sorensen goes on to teach that the PDA may include a display used to notify the user of various other features. (Col. 5, Ln. 7-9). But, Sorensen fails to specifically disclose displaying an indicator. However, in light of the aforementioned teachings, it would have been obvious to one of ordinary skill in this art at the time of applicant’s invention to modify the teaching of Sorensen in order to provide a remote device capable of alerting the user to the presence of interactive data via the device display.

Claims 10 and 18 correspond to the entertainment system claim 2. Therefore, each is analyzed and rejected as previously discussed.

Claim 3 recites the entertainment system of claim 2, wherein the display changes background colors to indicate the availability of the interactive function in the program corresponding to the EPG. As discussed above, the combined systems of Ellis and Sorensen disclose all limitations of claim 2, and Sorensen further teaches that the personal digital assistant (PDA) may generate *any form* of notification to alert the user to the presence of interactive data. (Col. 3, Ln. 22-36). In light of this teaching, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to modify this teaching of Sorensen in order to provide a system providing changes to background colors, thereby supplying an alternative method of alerting a user to the presence of interactive data corresponding to the EPG.

Claims 11 and 19 correspond to the entertainment system claim 3. Accordingly, each is analyzed and rejected as previously discussed.

Claim 4 recites the entertainment system of claim 2, wherein the display flashes to indicate the availability of the interactive function in the program corresponding to the EPG. As discussed above, the combined systems of Ellis and Sorensen disclose all limitations of claim 2, and Sorensen further teaches that the personal digital assistant (PDA) may comprise an LED which flashes, thereby alerting the user to the availability of the interactive function. (Col. 3, Ln. 22-36). Accordingly, the combined system of Ellis and Sorensen contain all limitations of claim 4.

Claims 12 and 20 correspond to the entertainment system claim 4. Thus, each is analyzed and rejected as previously discussed.

Claim 5 recites the entertainment system of claim 1, wherein the entertainment system is a personal digital assistant. As discussed above, the combined systems of Ellis and Sorensen

disclose all limitations of claim 1, and Ellis and Sorensen further teach that the remote device can be a PDA. (Par. [0092] & Col. 2, Ln. 33-34, respectively). Accordingly, the combined system of Ellis and Sorensen contain all limitations of claim 5.

Claims 13 and 21 correspond to the entertainment system claim 5. Thus, each is analyzed and rejected as previously discussed.

Claim 7 recites the entertainment system of claim 1, wherein the indicator is a unit that generates a sound to indicate the availability of the interactive function in the program corresponding to the EPG. As discussed above, the combined systems of Ellis and Sorensen contain all limitations of claim 1, and Sorensen further teaches the alert can be a sound. (Col. 3, Ln. 22-36). Accordingly, the combined system of Ellis and Sorensen contain all limitations of claim 7.

Claims 15 and 23 correspond to the entertainment system claim 7. Therefore, each is analyzed and rejected as previously discussed.

Claim 8 recites the entertainment system of claim 1, wherein the indicator is a section of the entertainment system that illuminates to indicate the availability of the interactive function in the program corresponding to the EPG. As discussed above, the combined systems of Ellis and Sorensen contain all limitations of claim 1, and Sorensen further teaches the alert can be an LED, which may remain lit (i.e., illuminate). (Col. 3, Ln. 22-36). Accordingly, the combined system of Ellis and Sorensen contain all limitations of claim 8.

Claims 16 and 24 correspond to the entertainment system claim 8. Therefore, each is analyzed and rejected accordingly.

5. Claims 6, 14, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Sorensen as applied to claim 1 above, and further in view of Elliot. (US Pat. No. 6,473,097).

Claim 6 recites the entertainment system of claim 1, wherein the entertainment system is a web phone. As discussed above, the combined systems of Ellis and Sorensen contain all limitations of claim 1, and Ellis further teaches the hand held device can be any suitable computer based device (which could be broadly interpreted as encompassing a web phone). (Par. [0092]). But, neither disclosure specifically recites the use of a web phone. However, within the same field of endeavor, Elliot discloses a web phone capable of receiving multimedia data via the Internet, which is transmitted over RF frequencies. (Col. 3, Ln. 35-45 & Col. 4, Ln. 36-46).

Although Applicant has argued this reference is non-analogous, the Examiner disagrees. In the interest of full disclosure, Elliot was cited to show that “web-phones” were well known in this art (i.e., telecommunications) at the time of Applicant’s invention. Elliot is analogous to Applicant’s alleged invention because Claim 6 recites a “web-phone” and Elliot discloses a Internet capable cell phone (i.e., web phone). In light of these teachings, it would have been obvious to one of ordinary skill in this art at the time of applicant’s to combine the systems of Ellis and Sorensen with the system of Elliot in order to provide a web phone capable of alerting a user of interactive data corresponding to an EPG, thereby providing a remoter terminal with extended capabilities.

Claims 14 and 22 correspond to the entertainment system claim 6. Accordingly, each is analyzed and rejected as previously discussed.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Jade O. Laye

November 8, 2005.



CHRIS KELLEY  
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